The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN Y.F. PANG

Appeal No. 2006-1410
Application No. 09/353,537

ON BRIEF

Before JERRY SMITH, RUGGIERO, and MACDONALD, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests that we reconsider our decision of June 30, 2006 in which we sustained the rejection of claims 1-20 as unpatentable under 35 U.S.C. § 103.

We have reconsidered our decision of June 30, 2006 in light of appellant's comments in the request for rehearing, and we find no errors therein. We, therefore, decline to change our prior decision for the following reasons.

Appellant first asserts that the Board allegedly overlooked the "true interpretation" of the claimed policing server [request, page 1]. Specifically, appellant notes that the term "policing server" was explained as "a server that performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers" [request, page 2; emphasis in original]. Appellant contends that McCormick's filtering system does not reduce the incidence of further SPAM messages sent from one or more spammers, but rather teaches blocking messages at a filter [request, page 3]. Appellant emphasizes that "policing servers" perform pro-active actions responsive to unwanted email well beyond merely updating an email filter [request, page 2].

We find appellant's arguments unpersuasive. We did not overlook appellant's definition of "policing server" on page 7 of the brief, but rather expressly acknowledged it in our decision [decision, page 8]. But we further noted that, absent a clear definition of "policing" in the specification, we were required to give the term its plain meaning [id.]. In ascertaining the plain meaning of "policing," we cited a dictionary definition[1] and concluded that the broadest reasonable interpretation of "policing server" did not preclude McCormick's server that periodically updates users' email filters [id.].

[1] "Dictionaries or comparable sources are often useful to assist in understanding the commonly understood meaning of words and have been used both by [the Federal Circuit] and the Supreme Court in claim interpretation." Phillips v. AWH Corp., 415 F.3d 1303, 1322, 75 USPQ2d 1321, 1333 (Fed. Cir. 2005).

Significantly, appellant's definition of "policing server" on page 7 of the brief is not expressly recited in the specification.[2] Although the specification may support appellant's definition of "policing server" in the brief as appellant indicates [see brief, page 7], the specification hardly defines the term in a manner that precludes a plain meaning interpretation of "policing." Accordingly, our reliance on the plain meaning of "policing" was appropriate.

We realize that our reliance on a dictionary in assisting us in understanding the commonly understood meaning of "policing" "...must ensure that any reliance on dictionaries accord with the intrinsic evidence: the claims themselves, the specification, and the prosecution history." Free Motion Fitness, Inc. v. Cybex Int'l, Inc., 423 F.3d 1343, 1348, 76 USPQ2d 1432, 1436 (Fed. Cir. 2005) (internal citations omitted). The plain meaning of "policing" that we adopted in the decision, however, fully comports with the intrinsic evidence. Certainly, the policing server described in the specification that reports senders' violations "controls, protects, or keeps orderly" user's inboxes from unwanted email.

"During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow." In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (emphasis added). In our view, restricting

[2] We note, however, that the specification of the present application incorporates by reference provisional application 60/093,120 [specification, page 1] which further describes a "policing server." Although not repeated in the utility application, the provisional application states that a "policing" server is "any server that can report out violations of a sender" [provisional application, page 5, lines 20 and 21]. In our view, McCormick's server that periodically updates users' filters reasonably meets this description in that the sender's "violations" (i.e., unwanted email transmissions) are "reported" to the user via filter updates.

our interpretation of "policing server" to appellant's narrower definition on page 7 of the brief is tantamount to impermissibly importing limitations from the specification into the claims. See Phillips v. AWH Corp., 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) ("[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments...[P]ersons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments."). We therefore find no error in declining to adopt appellant's narrower definition of "policing server" offered in the brief.

Furthermore, we find no error in our conclusion that appellant's definition of "policing server" on page 7 of the brief does not preclude filtering unwanted email via a server. As we noted, filtering unwanted email is an action that would, at least at the user's inbox, reduce the incidence of further identical SPAM email messages sent from the same spammer [decision, page 8; emphasis added]. Even assuming that SPAM email messages were not stopped at the source as appellant argues, filtering email messages would nevertheless reduce the incidence of identical SPAM email messages sent from the same spammer at the user's inbox. That is, at least from the user's perspective, the incidence of such SPAM email messages would be reduced.

In short, we disagree with appellant that we overlooked appellant's definition of "policing server" on page 7 of the brief. On the contrary, we

acknowledged appellant's definition, but reasonably interpreted the term more broadly based on the plain meaning of the term "policing." As we indicated in our decision, our interpretation did not preclude the teachings of McCormick.

We further acknowledge appellant's argument regarding the citation of the secondary references Gianni and Macavinta on pages 3 and 4 of the request, but appellant merely reiterates that the prior art fails to disclose a policing server that stops SPAM at the source. We are not persuaded by appellant's argument, however, and we decline to adopt appellant's definition of "policing server" for the reasons previously discussed.

We have carefully considered the arguments raised by appellant in the request for rehearing, but none of these arguments are persuasive that the original decision was in error. We are still of the view that the invention set forth in claims 1-20 is not patentable over the applied prior art based on the record before us in the original appeal.

We have granted appellant's request to the extent that we have reconsidered our decision of June 30, 2006, but we deny the request with respect to making any changes therein.

REHEARING DENIED

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Administrative Patent Judge)
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